

Application Serial No. 09/740,051  
Reply to Office action of Aug. 24, 2004

## Remarks

Claims 1-18 stand rejected. By this amendment, claims 1, 3, 4, 12, and 14 have been amended and new claims, dependent claims 19-23 and independent claim 24, have been added. The commissioner is authorized to charge Deposit Account #502997 the required fee for these newly added claims.

The Examiner's rejection's are traversed below. Applicant respectfully requests withdrawal of all rejections. With this amendment, Applicant believes the application is in condition for allowance

Applicant respectfully points out that the present application properly claims and is entitled to priority under 35 USC 119(e) for U.S. provisional application Serial No. 60/172,397 filed on December 17, 1999.

### *Rejections Under 35 USC 102 and 103*

Claims 1-2, 5, 8, 10-12, 14 and 17-18 have been rejected under 35 USC 102(e) as anticipated by Suliman et al. Applicant respectfully traverses the rejections.

The reference relied on by the Examiner, Suliman et al., U.S. published Patent Application US20010053980, filed Dec 16, 2000, claims priority to U.S. provisional application Serial No. 60/172,351, filed Dec 16, 1999. Applicant respectfully points out that only subject matter of the published application, which finds support in the provisional application, can be used to make a rejection under 35 USC 102 and 103.

The following are pertinent extracts are from the Examination Guidelines for 35 U.S.C. § 102(e), as amended by the American Inventors Protection Act of 1999, and further amended by the Intellectual Property and High Technology Technical Amendments Act of 2002, and 35 U.S.C. § 102((g))

DISCUSSION: Sections I – V below set forth the USPTO's examination procedures for the amendments to 35 U.S.C. § 102((e)) made by the AIPA and H.R. 2215.  
IV) Examination Procedures under 35 U.S.C. §§ 102((e)) and 374

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The § 102(e) date of a reference that did not result from, nor claimed the benefit of, an international application is its earliest effective U.S. filing date, taking into consideration any proper priority or benefit claims to prior U.S. applications under §§ 119(e) or 120 if the prior application(s) properly supports the subject matter used to make the rejection.

**Example 2: Reference Publication and Patent of § 111(a) Application with Priority/Benefit Claim to a Prior U.S. Provisional or Nonprovisional Application**

For reference publications and patents of patent applications filed under 35 U.S.C. § 111(a), the prior art dates under § 102(e) accorded to these references are the earliest effective United States filing dates. Thus, a publication and patent of a § 111(a) application, which claims priority under 35 U.S.C. § 119(e) to a prior U.S. provisional application or claims the benefit under 35 U.S.C. § 120 of a prior nonprovisional application, would be accorded the earlier filing date as its prior art date under § 102(e), assuming the earlier-filed application has proper support for the subject matter as required by §§ 119(e) or 120.

Applicant has obtained a copy of the priority document, U.S. provisional patent application Serial No. 60/172,351, and provides it herewith for Examiner's review and comparison with the Suliman et al reference relied on by the Examiner. Applicant respectively points out that that there is significantly less disclosure in the priority document than in the non-provisional application (Suliman et al, Serial No. 09/738,664) relied on by the Examiner, and most of the material relied on by the Examiner is not found in or supported by the priority document, as discussed further herein. In fact, the priority document contains only one figure which relates to invention described therein and describes only one primary embodiment of blind warranty registration as is now described. As noted above, only the disclosure in the priority document (Ser No. 60/172,351) can be used to make rejections of the present application under 35 USC 102 and 103.

Suliman et al. teaches a method of blind electronic warranty registration whereby purchasers, utilizing their personal computers, can voluntarily register their purchased products with an intermediate server, and whereby the intermediate server can communicate product and non-personal purchaser information to the product manufacturer thereby maintaining the privacy of the purchaser while registering the product with the manufacturer. The purchaser, using their computer to connect with a server over a network, registers with the server providing personal information as well as information about the product they have purchased. The central server stores this information and creates a customer identifier for the purchaser which is stripped of personal or private information about the purchaser. The server then transmits the product information along with the non-personal purchaser information to the manufacturer of the product. This blind registration method purportedly allows purchasers to register their products with the

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manufacturers, using an intermediate server, and thereby shield their identity from the manufacturer and maintaining their privacy.

Specifically and with reference to the text and lone figure of U.S. provisional application Serial No. 60/172,351, Suliman at al. discloses a blind registration method and system (100) wherein a customer, having purchased a product, utilize his or her own personal computer (22), to transmit both personal information and product information to a server (10) where part of the information is processed stored in database (12, 14). The server 10 subsequently transmits a customer identifier, but stripped of personal information, along with product information to the manufacturer of the product (32). Although the method and system disclosed by Suliman disclose a method to register purchased products, such method requires and is dependent on the purchaser actively connecting to server 10 via their personal computer, registering with their personal information, and manually entering product information (e.g., make, model, serial no.). Suliman requires the purchaser to enter product information and also requires the purchaser to register with a central server, and this is how the central server obtains both information about the customer and information about the asset (i.e., both customer and product information being manually provided by the customer). Moreover, the remote server creates and maintains the customer data at the remote server after the customer has initially registered with the server, and every time the customer wishes to blind register another product, the customer must login to the server and enter the product information, at which point the remote server associates the product data with the customer data, already stored at the remote server.

Suliman does not disclose or teach a method or system for the electronic or automatic registration of assets wherein a data file specific to an entity that purchases or owns assets is in the possession of the entity, but teaches rather that the entity specific data file is located on a remote server. Furthermore, there is no disclosure or teaching by Suliman that this datafile, in possession of the entity, is installed on a media accessible to third parties computer.

Suliman does not disclose or teach a method or system for the automatic registration of assets wherein the product or asset information is not provided by the user, but for example is provided by the seller, distributor, manufacture, or other 3<sup>rd</sup> parties as in

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particular embodiments of the present invention. Suliman requires the customer to manually enter the asset information.

Suliman does not teach the registration of assets at the time of purchase.

Suliman does not disclose a machine readable media, in possession of an entity with a data file thereon for the automatic registration of assets.

Additionally, Suliman does not teach or contemplate an electronic data file is in possession an entity and which is modifiable by the customer as in particular embodiments of the present invention, but rather requires the customer to logon to the remote server in order to create and modify the customer data.

Suliman does not disclose a method or media for the automatic insuring of assets, nor does Suliman disclose a media and method wherein the registration database provides a composite record of assets of specific entities.

Applicant respectfully submits that claims 1-2, 5, 8, 11-12, 14 and 17-18 are not anticipated by Suliman, that claims 3-4, 6-7, 9, 13, and 15-16 are not obvious in view of Suliman, and newly added claims 19-24 are neither anticipated by nor obvious in view of Suliman, as discussed in detail below.

With respect to independent claims 1 and 12, Applicant respectfully submits that the subject matter claimed therein patentably distinguishes over Suliman. Specifically, claim 1 as amended recites a method for electronic asset registration comprising "providing an electronic data file comprising data specific to an entity ... wherein the electronic data file is in the possession of the entity". As discussed above, Suliman does not disclose that the electronic file with entity specific data is in the possession of the entity, for example on the entity's computer or on a smart card or credit card carried by the entity, but teaches that the electronic file is created at the remote server after the entity registers and inputs information into the remote server. Claim 1 further recites "extracting the data specific to the entity from the electronic file", "and entering it into the registration database". Suliman does not disclose extracting the data from a file in possession of the entity, but rather teaches that the entity specific data is extracted at the remote server. Claim 12 recites "a machine-readable media having thereon a data file comprising data specific to an entity that owns or purchases assets; whereby data is extracted from the data file for use in automatic registration of assets and wherein the machine-readable media is

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in the possession of the entity". Suliman does not disclose such a media containing a datafile which is in possession of the entity, but teaches that the media and datafile are created and stored at a remote server.

As discussed above, Suliman does not show or suggest either a method or media for the electronic or automatic registration of assets wherein a data file specific to an entity is in possession of the entity. As stated by the Federal Circuit:

**Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claim invention, arranged as in the claim**

*Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). This, the Examiner has not done. Thus, Applicant submits that amended claims 1 and 12 patentably distinguishes over Suliman. Withdrawal of the rejections is respectfully requested.

In addition, the present invention as recited in claims 1 and 12 provides benefits which are not provided or contemplated by Suliman. Specifically, one embodiment of the present invention provides for a data file with entity specific information to be in the possession of the entity, and does not depend or require the entity to initially manually register with a remote server via the entity computer's and input the various entity specific information. This aspect results in much less effort on the part of the entity and facilitates the automatic registration of assets. Furthermore, it allows for the entity to possess a single file, e.g., on the entity's computer or on the entity's credit or smart card, that can be used to register assets owned or purchased by the entity by a variety of mechanisms and with a variety of differing parties, and does not require the entity to utilize a specific central remote server or require the entity to logon to the same registration server each time the entity wishes to register an asset. The present invention can dramatically reduce the effort required by the entity to register an asset and thus greatly encourages and facilitates asset registration. For instance, if the data file is located on the smart or credit card of the entity, the registration can take place with no effort from the entity as the entity specific information is extracted electronically from the entity's card. Additionally, if the data file is located on the entity's computer, the entity need only reference the data file or "drag and

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drop" the file icon during the registration of the entities assets, and said data file can be used with any number of interested parties, for example any number of different web sites, stores, and servers. This "one-click" registration is vastly more efficient easier than the registration system disclosed by Suliman, which requires not only the entity to logon to a specific server but to input the entity data. Both of the aforementioned examples allow for the data file or information contained therein to be extracted automatically by third parties' computers. The benefits of the invention are gained by the purchaser/owner entity as well as other interested parties including manufacturer, distributor, marketer, etc., in the ease and seamlessness of registering assets and receiving all the benefits therefrom.

With respect to Claim 18, Applicant respectfully submits that the subject matter claimed therein patentably distinguishes over Suliman. Claim 18 recites "a machine-readable media having thereon a data file comprising data specific to an entity that owns or purchases assets; whereby data is extracted from the data file for use in automatically insuring assets." Suliman does not disclose or suggest such a media with a data file containing entity specific data whereby the data is extracted for use in automatically insuring assets. Claim 18 would not have been obvious in view of Suliman for many of the same reasons recited above. The potential immediate availability and use of the entity data by the entity, the insurer, or other interested party, in order to facilitate and timely insure assets and create records of the same provides benefits to owner and insurer alike, and is not suggested by the prior art. Withdrawal of the rejection is requested.

With respect to Claim 24, Applicant respectfully submits that the subject matter claimed therein patenably distinguishes over Suliman. Claim 24 like Claim 1 recites a method for electronic asset registration including the step of "entering data specific to an asset into the registration database", and further recites "wherein said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data". Suliman discloses and teaches that the customer must enter the asset specific data via the customer's personal computer. Indeed, in Suliman, this step is a key requirement of the invention described therein, as it is necessary to maintain the "blindness" of the warranty registration. Suliman, does not disclose or suggest a method of asset registration in which the entity does not directly provide the asset data, but in fact teaches away from this embodiment of the present

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invention in which the asset registration does not depend on the entity entering the asset specific data. In addition, the invention recited in Claim 24 provides additional benefits not suggested by the prior art, including seamless and effortless asset registration on the part of the entity, where asset data may be automatically extracted at the point of sale, either online or at a POS terminal for example, thus obviating any asset data input or purchasing entity and reducing effort, while providing the registration benefits to the entity's as well as to various third parties, including manufacturers, distributors, sellers, and insurers, as discussed above. An important advantage of the present invention is that the purchaser does not have to manually enter the data necessary for asset registration for each asset purchase. Another important advantage of the invention is that it can provide the purchaser or an interested third party a simple and straightforward way to provide, in an electronic format, all of the purchaser's registration information, such that each time a purchase is made, registration can be accomplished with much reduced effort on the participating parties while providing various benefits to each. Withdrawal of the rejection is requested.

Dependent claims 2-11, and 19-23 which depend, directly or indirectly, from independent claim 1, and incorporate all the limitations of claim 1, also include additional limitations which are not shown or suggested by the prior art as discussed above. For example, claim 2 recites that "the registration is performed during the purchase of the asset", a feature which may facilitate and expedite the registration process requiring little effort from the purchaser. Claims 3-7 recite features including: "the electronic data file is provided on a media that is loaded onto a purchasing entity's or owner entity's computer", "the data file is an electronic file installed on a smart card or credit card"; "the data specific to an entity is extracted by an application on a second computer through a computer network", "electronic file is installed on a media accessible to a third party's computer", "wherein the third party is a credit card company". Claim 8 and 9 recite "wherein the data file includes data for insuring an asset" and "wherein an insurer has access to the electronic registration database and automatically insures an asset when it is registered." Claims 10 and 11 recite "wherein the registration database provides a composite record of assets registered by specific entities" and "wherein the entities maintain control over personal, and or entity registration data." Claim 19 recites "wherein

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said asset specific data is not manually provided by the entity and the entering of said data does not depend on the entity directly providing said asset specific data", and claim 23 recites "wherein the entity is able to directly modify the entity specific data."

Dependent claims 13-17 which depend, directly or indirectly, from independent claim 12, and incorporate all the limitations of claim 1, also include additional limitations which are not shown or suggested by the prior art.

Thus, for these reasons and for the reasons discussed above, Applicant respectfully submits that dependent claims 2-11, 13-17, and 19-23 patentably distinguish over Suliman. Withdrawal of these rejections is respectfully requested.

### *Rejections Under 35 USC 103*

Claims 3-4, 6-7, 9, 13, and 15-16 have been rejected under 35 USC 103(a) as obvious in view of Suliman et al. Applicant respectfully traverses the rejections. Claims 3-4, 6-7, and 9, and claims 13, and 15-16 depend either directly or indirectly from independent claims 1 and 12 respectively incorporating all the limitations of those respective claims and also include additional limitations and are therefore not obvious in view of the prior art for the reasons stated above and are allowable over the prior art as discussed above. Applicant nevertheless believes that the rejections made under 35 USC 103 are improper as discussed below, and respectfully requests withdrawal of the rejections.

With regard to claims 3, 4, and 13, the Examiner takes Official Notice that "maintaining a data file on a home computer, and having the data and/or file itself extracted from the computer remotely over the Internet is old and well known in the art". Examiner then concludes that it would have been obvious to modify Suliman to include "the media for and step of: maintaining purchaser information on the purchaser's own computer". The Examiner further states that the reason for the modification of Suliman would "simply be to increase the ease and convenience to users of the product registration system. The system would be much more user friendly". Applicant respectfully submits that the rejections are improper and should be withdrawn. Firstly, Applicant requests the Examiner to provide substantiating evidence (e.g., in the form of an affidavit under 37 CFR 1.107(b)) to support Examiner's assertion that "maintaining a data file on a home



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computer and having it extracted from a computer remotely” is old and well known in the art. Secondly, Applicant respectfully submits that Examiner’s reason for modification of “increase in efficiency” is improper and should be withdrawn because it is too vague and general, could cover almost any modification of Suliman, and does not address why this specific proposed modification would have been obvious. Moreover, there is no disclosure or teaching in Suliman of maintaining the entity data on the entity’s computer or for that data to be extracted by a third party computer. In fact, Suliman teaches away from this, requiring the purchaser do deliberately connect to a remote computer and manually send data to the remote computer. The following extract is quoted from the Patent Office’s guidelines:

FORMULATING AND COMMUNICATING REJECTIONS UNDER 35 U.S.C. 103 FOR APPLICATIONS DIRECTED TO COMPUTER-IMPLEMENTED BUSINESS METHOD INVENTIONS. <http://www.uspto.gov/web/menu/busmethp/busmeth103rej.htm#V>

V. Examples of Improper Rejection under 35 U.S.C. 103

The motivation, improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious. ...The rejection is improper

With regard to claims 6 and 15 the Examiner takes Official Notice that “credit card companies are interested in procuring information about users”, and concludes that it would have been obvious to modify Suliman “to include a credit card company as a third party whose computer has access to the purchaser/customer data file”. Examiner further states that the reason for the modification would be “that credit card companies have a stake in many transactions, for example, when extended warranties are automatically granted due to the use of the card” and “efficiency in processing warranty requests would improve, thereby increasing customer satisfaction”. Applicant respectfully submits that the rejections are improper and should be withdrawn. Firstly, the assertion by the Examiner “that credit card companies are interested in procuring information about users” is too general and unqualified, and would appear to imply that any information for any purpose regarding users would be desired by credit card companies. Applicant disagrees and points out there is no suggestion of credit card companies desiring entity data for use

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in the registration of assets. If the Examiner has knowledge of such interests by credit card companies, Applicant requests Examiner to provide evidence, e.g., in the form of an affidavit under 37 CFR 1.107(b)) to substantiate Examiner's assertion. Secondly, Examiner reasons for the modification of Suliman are because "credit card companies have a stake.... when extended warranties are granted due to the use of the card", and for "efficiency in warranty processing". As discussed above and in accordance with the USPTO guidelines on rejections, "efficiency" is an improper reason as it is too general. Moreover, the granting of extended warranties to credit card users as an incentive to use a particular credit card is a different service, and does not involve asset registration. The credit card companies do not keep track or register the assets for the purchasers, but in fact require the purchaser to prove at some later time, if the purchaser wants to avail themselves of the extended warranty, that the purchased product is entitled to extended warranty protection (e.g., by providing a receipt and a copy of the manufacturers warranty).

Furthermore, the relevance and meaning of Examiners reference to Para. 3 lines 14-18 of Suliman is not understood by the Applicant. There is no mention or reference to credit card companies in the Suliman priority document.

With regard to claims 7 and 16 the Examiner takes Official Notice that "use of a smart card to store data is old and well known in the art" and so it would be obvious to modify Suliman to "include a media and step for storing purchaser specific data on a smart card". The Examiner's reason for modification is "to increase efficiency in associating product data with purchaser data by allowing an easier process of transmitting purchaser data ...". The rejections are improper and should be withdrawn. Firstly, storing data on smart card is well known and is in fact the primary purpose of a smart card. However there is nothing in Suliman that would suggest that the motivation for modification is known outside of Applicant's specification. Although storing data on a smart card is well known, storing and utilizing data for the registration of assets is not, and there is nothing in Suliman to suggest the claimed media or step. Again, Suliman teaches away from this by requiring the purchaser to actively connect to a remote server in order to register assets. Furthermore, as discussed above, the Examiner's reason to modify of "to increase efficiency" is too vague and does not address why such a modification would have been obvious.

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With regard to claim 9, Examiner states that Suliman does not teach the step “wherein an insurer has access to the electronic registration database and automatically insures an asset when it is registered”. Examiner further states that Suliman does suggest “the possibility of automatically insuring an asset once register, in the sense that insurance is a product related service. ( Examiner references Para. 14 lines 1-3 and Para 63 lines 1-5). Examiner then states that it would be obvious to modify Suliman, the reason being, as expressed in Suliman: “to make available those services and products that are necessary or desirable for use and enjoyment of the asset.” Applicant traverses the rejection. The Suliman priority document does not suggest the possibility of insuring assets or of interests from insuring parties (e.g., Para 63 is not present). Although Suliman does suggest that once an asset is registered, recall or maintenance information can be sent to the purchasers, Examiner appears to be attempting to make equivalent the “automatic insuring of an asset” with that of “sending maintenance or recall information” by classifying both as a “product related service.” Such a generalization is improper as it would imply that any “product related service is effectively disclosed in Suliman, which is not the case. Examiner’s reason for modification is not understood by the Applicant as the passage quoted by the Examiner, “to make available those services and products that are necessary or desirable for use and enjoyment of the asset” is not found in Suliman as far as Applicant can determine. Furthermore, such a reason is too vague and broad. There is nothing in Suliman that would suggest the modification to include insuring the asset. The rejection should be withdrawn.